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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/729,236	12/05/2003	Roger Thomas	P-US-PR-1105	9203
28268 7590 04/19/2007 THE BLACK & DECKER CORPORATION 701 EAST JOPPA ROAD, TW199 TOWSON, MD 21286			EXAMINER SELF, SHELLEY M	
			ART UNIT 3725	PAPER NUMBER

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/19/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/729,236

Applicant(s)

THOMAS, ROGER

Examiner

Shelley Self

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 1/31/07.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1/31/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

The amendment filed on January 30, 2007 has been considered but is ineffective to overcome the prior art reference and an action on the merits follows.

Terminal Disclaimer

The terminal disclaimer filed on January 30, 2007 disclaiming the terminal portion of any patent granted on this application, which would extend beyond the expiration date of U.S. Patent No. 7,108,028 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 2-7, are rejected under 35 U.S.C. 102(b) as being anticipated by Brodhead (157,369). Brodhead discloses a debris collection container comprising a receptacle (fig. 1), the receptacle defining an aperture (fig. 1-3), a cap (fig. 3) releasably attached to the receptacle, wherein the cap is releasably attached to the receptacle by a means for connecting, the means for connecting comprising a first part including two pegs (fig. 1; col. 2, lines 5-6); the second part including a T-shaped slot (c; fig. 2); and wherein one of the first part and the second part is

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mounted on the receptacle and the other of the first part and second part is mounted on the cap (Fig. 1-3) the first and second part are connectable to each other by insertion of the pegs (G).

As to the recitations “for a plane”, “for storage of debris” and “a connector connectable”; the recitations are functional, i.e. intended use and do not positively define any structure. Examiner notes an intended use recitation requires only an ability to so perform but does not positively define any structural limitations. As it relates to the planer, Examiner further notes no structure regarding the planer has been positively defined or recited, furthermore, the planer itself has not been positively recited and is recited only in combination with a functional recitation.

With regard to claim 2, Brodhead discloses a rim, the rim defining the aperture and the cap releasably attached to the rim.

With regard to claim 3, Brodhead discloses the aperture is fixed and relatively large.

With regard to claim 4, Brodhead discloses the cap releasably attachable to the receptacle via a connector having a curved portion (G).

With regard to claim 6, Brodhead discloses the connector integrally formed with the cap (fig. 3).

With regard to claim 7, Brodhead discloses wherein the cap further includes a part spherical shaped section (fig. 3).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brodhead (157,369) in view of Wang (6,712,106). Brodhead does not disclose curving entrained debris through ninety degrees, a transparent window in said cap or transparent cap. Wang teaches in a similar art, a connector curving debris through 90 degrees, wherein the connector is attached to a cap that is releasably attached to a receptacle for storage of debris. Because the references are from a similar art, and deal with a similar problem, i.e. storage debris it would have been obvious to the skilled artisan at the time of the invention to replace, Brodhead's connector with a connector that entrained debris 90 degrees so as to reduce clogging of debris in the connector as it is deposited to the receptacle as taught by Wang.

Claim 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brodhead (157,369) alone or in view of Van Swearingen (3,952,484). Brodhead does not disclose a transparent cap window or transparent window. It would have been obvious at the time of the invention to one having ordinary skill in the art to construct Brodhead having a transparent window or transparent connector because it is well within the general skill of a worker in the art to select a known material on the basis for its suitability for the intended use as a matter of obvious design expedients. See *In re Leshin*, 125 USPQ 416.

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More, Van Swearingen teaches in a closely related art, the use of a cap in conjunction with a receptacle for debris storage, the cap constructed of transparent material (col. 1, lines 61-63) so as to observe cut debris deposited to the receptacle. Because the references are from a similar art and deal with a similar problem, i.e., collection and storage of debris it would have been obvious to the skilled artisan at the time of the invention to construct Brodhead's connector having a transparent window or made of transparent material so as to monitor debris as it is deposited into the receptacle.

Claim 11-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brodhead (157,369) in view of Mueller (3,014,516). Brodhead does not disclose a deformable section, first and second rigid sections or a spring. Mueller teaches in a closely related art, a receptacle having a deformable section, first and second rigid sections a spring forming part of a wall structure of the receptacle to facilitate deforming the receptacle for improved portability. Because the references are from closely related art, it would have been obvious at the time of the invention to one having ordinary skill in the art to replace, Brodhead's receptacle with one having deformable section, with first and second rigid sections and a spring so as to facilitate portability of the receptacle as taught by Mueller.

Response to Arguments

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shelley Self whose telephone number is 571-272-4524. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on 571-272-4419. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


SHELLEY M. SELF
PRIMARY EXAMINER
April 16, 2007